

**REMARKS**

The rejection of claims 1-4, 11-16 and 20-39 under 35 U.S.C. §103(a) as being unpatentable over Davis in view of Mullin and Schmid is respectfully traversed. At the outset, it must be noted that all of the rejected claims had previously been indicated as patentable, either by the Examiner herself, or by an Administrative Patent Judge.

Thus, in a paper signed by Examiner Margaret Medley (copy attached as Exhibit A) in parent application 08/442,611, which application was involved along with the present application in Interference No. 104,179 the Examiner stated that:

“The instant U.S. application 08/896,060 contains patentable claims 1-4 and 13-16...” and that “...claims 1-4 and 13-16 of application 08/896,060 would be designated to correspond to the count.” The Examiner is now rejecting these very same claims. It is respectfully submitted that applicants, having won the interference, should be granted a patent on the claims which the Examiner had previously indicated were patentable.

Moreover, in this same paper, in application serial number 08/442,611, the Examiner indicated that “Claims 11-12, 20-37 and 39 of application 08/896,060 are not deemed to contain a patentable blend of esters and a method for using said blend.” However, during the pendency of Interference No. 104,179, the party adverse to applicants in that interference, Morrison, moved to designate claims 11-12 and 20-39 as corresponding to the count, arguing that these claims are not patentably distinct from the esters covered by the count. The Administrative Patent Judge, Ms. Adriene Hanlon, granted that motion in a decision dated April 10, 2001. Notwithstanding that the Administrative Patent Judge ruled that these claims correspond to the

count of the interference, and therefore they must be patentable for the same reasons that the count is patentable, the Examiner has not given full faith and credit to the decision by the Administrative Patent Judge and has rejected these claims.

Furthermore, it is respectfully submitted that the combination of references relied on by the Examiner, i.e., Davis, Mullin and Schmid, does not render obvious the herein-claimed invention.

Davis teaches at column 2, lines 35-40, that two-cycle engine oil compositions comprise a major amount of an oil of lubricating viscosity. Davis further teaches at column 3, lines 36-40, that one type of oil of lubricating viscosity can be esters made from C<sub>5</sub>-C<sub>12</sub> monocarboxylic acids and such polyols as neopentyl glycol, trimethylolpropane, pentaerythritol, etc.

Applicants submit that the person of ordinary skill in the art of two-cycle engine oils would not be motivated to combine the teachings of Davis, Mullin, and Schmid to arrive at applicant's claimed two-cycle engine oil ester based stock because (1) Davis contains no teaching or suggestion that the esters taught at column 3, lines 36-40 would be biodegradable according to CEC Test Method CEC-L-33-T-82; (2) the esters taught at column 3, lines 36-40 of Davis do not meet the viscosity and pour point specifications required of a two-cycle engine oil; and (3) there is no suggestion that any of the esters of the prior art would be biodegradable according to CEC Test Method CEC-L-33-T-82.

The declaration of Steven C. Lakes, under 37 C.F.R. §1.132 (copy attached as Exhibit B) accompanying the amendment filed in grandparent application serial no. 08/119,318 shows that representative members of the class of trimethylolpropane esters taught by Davis at column 3,

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Amdmt dated November 11, 2003  
Reply to Office Action dated July 23, 2003

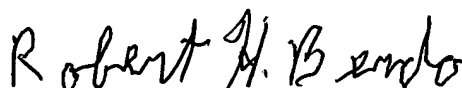
lines 36-40 would not meet the viscosity, pour point and biodegradability requirements for a biodegradable two-cycle engine oil. For example, the data in the table of the Lakes declaration shows that for an n-C<sub>5</sub> ester of TMP (trimethylolpropane), while the pour point and biodegradability are within specification, the viscosity is too low at 2.6cSt at 100° C. The data also shows that while an n-C<sub>12</sub> ester TMP exhibits an acceptable viscosity and biodegradability, the pour point is too high at +6° C.

Biodegradability is the crux of the herein-claimed invention and the failure of any of the references to disclose anything about biodegradability refutes the Examiner's contention that the combination of references renders the herein-claimed invention obvious.

Claim 42 has been added by this amendment. This claim corresponds substantially to original claim 41 which was inadvertently cancelled by preliminary amendment.

For the foregoing reasons, it is respectfully submitted that this application is now in condition for allowance and that it should be passed to issue. Such favorable action is earnestly solicited.

Respectfully submitted,



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Dated: November 11, 2003



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Count 1:

**1. A biodegradable oil composition comprising:**  
**(a) 20 to 85 wt. % of a heavy ester oil or mixture of heavy ester oils, wherein said heavy ester oil is characterized by a kinematic viscosity of at least about 7.0 cSt at 100°C., and**  
**(b) 10 to 85 wt% of a light ester oil or mixture of light ester oils, wherein said light ester oil is characterized by a kinematic viscosity of less than about 6.0 cSt at 100°C.,**  
**wherein said composition has a biodegradability of at least about 66% as measured by the CEC L-33-T-82 method.**

Patent No. U.S. 5,378,249 contains claim 1 a biodegradable oil composition comprising at least one heavy ester oil (e.g. triisostearate) and at least one light ester oil (e.g. tripelargonate) having specific viscosity and biodegradability and claims 4, 9 and 15 define the preferred heavy ester oils and light ester oils. The instant U.S. Application 08/442,611 contains patentable claims 5-6 and 44 which recites a composition consisting essentially of 20-60% trimethylolpropane triisostearate and 40-80% trimethylolpropane tripelargonate (claim 6 recites 42% and 58%, respectively, and claim 44 recites 41.2% and 58.8%, respectively). From the evidence presented with instant Application U.S. 08,442,611 petition, see Attachments A, B, and C, it is clear that the triisostearate (heavy ester oil) and tripelargonate (light ester oil) components of claims 5 and 6 inherently have the viscosity properties specified by the claim 1 of USP 5,378,249. Additionally, Example 1 of the instant application is sufficient evidence that the composition of the instant claims 5 and 6 would inherently have a biodegradability of at least 66% as specified by claim 1 of

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USP 5,378,249. Therefore, if available as prior art, the instant claims 5 and 6 would define the same patentable invention under 35 U.S.C. 102 or 103 as claim 1 of USP 5,378,249. The fact that the specifically claimed (and preferred) components of USP 5,378,249 (see claims 4, 9 and 15) are outside of the scope of the components instantly claimed is of no relevance to the issue of the claiming the same patentable invention since the disclosure of USP 5,378,249 (column 3, lines 3-53) broadly defines the heavy ester oil and light ester oil components by their viscosity and biodegradability properties.

The instant U.S. Application 08/896,060 contains patentable claims 1-4 and 13-16 (that the instant claim are so broadly that in this case they recite the same subject matter and therefore are also presumed to be allowable) which recite a composition consisting of a first polyol ester and a second polyol ester which encompass a blend of heavy ester oil and light ester oil having biodegradable of at least 66% and viscosity properties of a blend of heavy ester oil and light ester oil as specified by claim 1 of USP 5,378,249.

Claims 1-17 of U.S. 5,378,249; claims 5, 6 and 44 of application 08/442,611 and claims 1-4 and 13-16 of application 08/896,060 would be designated to correspond to the count. Claim 18 of U.S. 5,378,249, claims 38, 11-12, 20-37 and 39 of Application 08/896,060 and claims 7-10 and 45-47 of Application 08/442,611 do not correspond to the count.

Claim 18 of U.S. 5,378,249 is directed to a gasoline/oil mixture and defines a patentable invention from claims 1-4, 11-16 and 20-39 of U.S. 08/896,060 and claims 5-10 and 44-47 of U.S. 08/442,611. Claims 7-10 and 45-47 of U.S. 08/442,611 are directed to a composition

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comprising a different blend mixture of esters and other additives and defines a patentable invention from claims 1-4, 11-16 and 20-39 of U.S. 08/896,060 and claims 1-17 and 18 of Patent U.S. 5,378,249. Claim 38 of 08/896,060 is directed to a method for using a blend of esters (heavy oil esters and light oil esters) and defines a patentable invention from claims 1-18 of US 5,378,249, claims 5-10 and 44-47 of application 08/442,611 and claims 1-4 and 13-16 of application 08/896,060. Claims 11-12, 20-37 and 39 of application 08/896,060 are not deemed to contain a patentable blend of esters and a method for using said blend.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday - Thursday from 7.30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Prince Willis, can be reached on (703) 308-3050. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Margaret B. Medley/om

February 2, 1998

February 25, 1998

*Margaret B. Medley*  
MARGARET MEDLEY  
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GROUP 110-1111